

## **REMARKS**

Claims 46-65 are currently pending. In the Office Action dated September 15, 2008, claims 46, 49, 50, 53, 56, 57, 60, 63, and 64 were rejected under 35 U.S.C. § 103(a) as unpatentable over “Using Netscape Communicator 4, Special Edition” by Brown et al. (“Brown”) in view of U.S. Patent No. 6,122,657 to Hoffman Jr. et al. (“Hoffman”); claims 47, 51, 54, 58, 61, and 64 were rejected under 35 U.S.C. § 103(a) as unpatentable over Brown, Hoffman, and the FinePrint documentation (“FinePrint”); and claims 48, 52, 55, 59, and 62 were rejected under 35 U.S.C. § 103(a) as unpatentable over Brown, Hoffman and “Digester: Device-independent access to the World Wide Web” by Bickmore (“Bickmore”). Applicant respectfully traverses the rejections for the reasons set forth hereinbelow.

**A. Claims 46, 49, 50, 53, 56, 57, 60, 63, and 64 Are Not Obvious over Brown and Hoffman**

Applicant has disclosed and claimed a method, apparatus, and computer program product for processing a structured document in an application to generate and print a modified copy of a structured document by using user-configurable print parameters to remove one or more of the elements from the structured document prior to printing a hardcopy of the modified structured document. By configuring the print options *in an application* with one or more user-selectable print parameters prior to printing, the present invention may be incorporated in and used by applications, such as web browser applications (*see, e.g.*, claim 1), thereby allowing the printing resource conservation advantage to be selectively applied as desired to individual applications. In contrast, client proxy content filter solutions -- such as exemplified by the Hoffman reference -- uniformly apply any content filtering to all communications to and from a web browser application, without regard to whether a print option has been by the web browser application has received print request. Another deficiency with the cited art combination is that Hoffman's intermediate filter module dynamically filters all content stream communications to the client browser so that only the filtered content is displayed, and therefore fails to disclose or suggest Applicant's invention which print options are configured to effectively provide a print filter in the client machine/browser application so that, when the browser has already downloaded or retrieved the content associated with a particular structured document, the print filter may be activated in response to a print request to reduce physical resource consumption during printing by removing an element from a structured document. *See, e.g.*, claims 46, 53, and 60

(“configuring a print option, wherein the print option comprises one or more user-configurable print parameters that indicate a user preference with respect to reducing consumption of one or more physical resources during printing of the structured document by modifying the content of the structured document to remove one or more of the elements prior to printing”).

In rejecting the claims, the Examiner admits that Brown fails to disclose the claim requirements of “modifying the content of the structured document to remove one or more of the elements prior to printing” as they appear in both the “configuring a print option” and “generating a modified copy of the structured document” claim elements. *See, Office Action*, pp. 3-5 and 8. To overcome these admitted deficiencies in Brown’s disclosure, the Examiner cites to Hoffman’s disclosure at col. 30, lines 23-28, for its disclosure of a web filter that “is configured to kill ads or kill images larger than a preselected image size,” and makes the unsupported conclusion therefrom that “Though Hoffman is primarily concerned with the conservation of bandwidth, to one of ordinary skill in the art at the time of the invention, such filtering would have also contributed to the conservation of printer *physical resources* prior to printing the web page by the recipient since there would have been less content to print, thereby saving both paper and in/toner resources.” *Id.*, pp. 4-6.

In response, Applicant respectfully submits that the proposed combination of references does not meet or suggest the claim requirements for configuring a print option to reduce the consumption of physical resources during printing by modifying the content of a structured document to remove one or more elements prior to printing, and then subsequently generating and printing a modified copy of the structured document in accordance with the user-configurable print parameters by modifying the content of the structured document to remove one or more of the elements in accordance with the print option. In particular, Applicant submits that the attempted reliance on Hoffman to overcome the admitted Brown deficiencies is misplaced because Hoffman discloses a conventional client proxy approach for filtering content being displayed on a web browser. As disclosed in Hoffman with reference to Hoffman Figure 2B, a web client 245a is engaged in a communication session with one or more Web servers 280 across a communication link, such as an Internet or intranet connection, where the client 245a comprises a Web browser or microbrowser application which communicates with the Web server through communication layer 241, such as Microsoft Winsock. Hoffman discloses that a filter module 225 is functionally interposed between the browser or other client application 245a for

trapping and processing all communication between an application and the communication layer 241. Thus, as the Web browser 245a generates requests for content in order to retrieve a base Web page and its embedded or referenced objects (e.g., bitmaps or other graphic objects), the system issues HTTP commands or “methods” (e.g., “GET” commands) which are communicated to the Web server 280 via the communications layer and communications link. However, all outgoing commands are trapped by the filter module 225, which can modify or delete the command, generate new commands, and allow the command to pass unmodified. In addition, the filter module 225 receives all incoming content from the Web server 280, which allows the filter module 225 to identify elements within the content of the Web page and then perform some type of processing on the elements prior to forwarding the elements to the browser application 245a. For example, if the structured document is a markup language document, then the filter 245a can modify markup tags or the attributes within the markup tags, add markup tags, delete markup tags, and more generally modify, add, or delete elements within the document.

As seen from the foregoing, Hoffman’s filter module 225 dynamically filters a content stream to the client browser so that browser displays the content of a document, such as a Web page, only after receiving the content through the intermediate filter module 245. In contrast to Hoffman, the print filter functionality of the present invention performs some conceptually similar filtering operations, but is done in connection with print operations (not a browser display operation) that occur within the runtime environment of the client/browser machine in a different capacity. In particular, the present invention may be applied in a browser application that has already downloaded or retrieved the content associated with a particular document (e.g., in response to a specific user request to view a Web page) where the print configuration filter function is activated in response to a user request to print the document that has already been retrieved from a Web server and is being viewed by the user within a browser application window. In the claims, the print filter functionality is recited in the requirement of “configuring a print option” which allows a user to set “one or more user-configurable print parameters” which indicate “a user preference with respect to reducing consumption of one or more physical resources during printing of the structured document by modifying the content of the structured document to remove one or more of the elements.” When a print request is received “to print a hardcopy of the structured document being displayed within a browser window,” the print filter is activated to generate “a modified copy of the structured document for printing in accordance

with the user-configurable print parameters by modifying the content of the structured document to remove one or more of the elements in accordance with the print option,” and then the hardcopy of the modified structured document is printed. In this way, the print filter functionality of the present invention can be integrated with the runtime environment of a browser application in order to intercept a print job, to gain access to the data structures associated with a document that is being printed, to interpret the document properly, and to perform any type of filter operation on the document in order to reduce the consumption of resources when it is printed.

Based on the foregoing, the Examiner has not made the *prima facie* obviousness showing that all the claim limitations are taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Where a rejection is based on the assertion that all claim limitations are found in a number of prior art references, the fact finder must determine “[w]hat the prior art teaches, whether it teaches away from the claimed invention, and whether it motivates a combination of teachings from different references.” *In re Fulton*, 391 F.3d 1195, 1199-1200 (Fed. Cir. 2004). Putting aside for the moment the propriety of combining the Brown and Hoffman references, Applicant submits that the Examiner’s proposed combination of references is not sufficient to render the claims *prima facie* obvious because the proposed combination does not meet the claim requirements of processing a structured document in an application to generate and print a modified copy of a structured document by using user-configurable print parameters to remove one or more of the elements from the structured document prior to printing a hardcopy of the modified structured document, and then generating and printing a modified copy of a structured document in accordance with the user-configurable print parameters by modifying the content of the structured document to remove one or more of the elements in accordance with the print option. See, MPEP, § 2143.03 (“To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).”).

Because the Examiner has admitted that **Brown** fails to disclose “configuring a print option...” and “generating a modified copy of a structured document for printing...” by

removing structured document content elements, and because Applicant has shown that *Hoffman* likewise fails to disclose “configuring a print option...” and “generating a modified copy of a structured document for printing...” by removing structured document content elements prior to printing -- much less configuring a print option that indicates a user preference with respect to reducing consumption of one or more physical resources during printing of the structured document by modifying the content of the structured document to remove one or more of the elements prior to printing -- Applicant respectfully requests that the obviousness rejection of claims 46, 49, 50, 53, 56, 57, 60, 63, and 64 be withdrawn and that the claims be allowed.

**B. Claims 47, 51, 54, 58, 61, and 64 Are Not Obvious over Brown, Hoffman, and FinePrint**

In response to the Examiner’s rejection of claims 47, 51, 54, 58, 61, and 64 as being obvious over Brown, Hoffman, and FinePrint, Applicant respectfully requests reconsideration and withdrawal of the rejection because, as explained above, the proposed combination of references does not meet or suggest the claim requirements for configuring a print option in an application to reduce the consumption of physical resources during printing by modifying the content of a structured document to remove one or more elements prior to printing, and then subsequently generating and printing a modified copy of the structured document in accordance with the user-configurable print parameters by modifying the content of the structured document to remove one or more of the elements in accordance with the print option. These deficiencies are not remedied by the cited FinePrint reference which typifies the “printer driver” solutions over which the present invention provides an improvement by configuring the print parameters in an application prior to printing. In contrast, FinePrint discloses applying any user-selected print modifications only after the print command is selected. In addition, Applicant submits that the Hoffman reference would not be combined with the Brown and FinePrint references by one of ordinary skill in the art to produce Applicant’s print processing invention, since Hoffman discloses a “method for dynamic filtering of hypertext tags and content” for purposes of controlling “output to the browser which is to be ultimately rendered on screen for the user,” and is completely unconcerned with the print control objectives of the present invention. *See*, Hoffman Patent, Abstract, col. 3, lines 31-34 (emphasis added). For at least the foregoing reasons, Applicant respectfully requests that the obviousness rejection of claims 47, 51, 54, 58, 61, and 64 be withdrawn and that the claims be allowed.

**C. Claims 48, 52, 55, 59, and 62 Are Not Obvious over Brown, Hoffman, and Bickmore**

In response to the Examiner's rejection of claims 48, 52, 55, 59, and 62 as being obvious over Brown, Hoffman, and Bickmore, Applicant respectfully requests reconsideration and withdrawal of the rejection because, as explained above, the proposed combination of references does not meet or suggest the claim requirements for configuring a print option in an application to reduce the consumption of physical resources during printing by modifying the content of a structured document to remove one or more elements prior to printing, and then subsequently generating and printing a modified copy of the structured document in accordance with the user-configurable print parameters by modifying the content of the structured document to remove one or more of the elements in accordance with the print option. These deficiencies are not remedied by the cited Bickmore reference which discloses a "software system which automatically re-authors arbitrary documents from the World-Wide Web to display appropriately on small screen devices such as PDAs and cellular phones, providing device-independent access to the Web," and is wholly unconcerned with the print control objectives of the present invention. *See*, Bickmore, Abstract. In addition, Applicant submits that the Hoffman and Bickmore references would not be combined with the Brown reference by one of ordinary skill in the art to produce Applicant's print processing invention, since both Hoffman and Bickmore relate to browser display operations, and are completely unconcerned with the print control objectives of the present invention. *See*, Hoffman Patent, Abstract, col. 3, lines 31-34, and Bickmore, Abstract. For at least the foregoing reasons, Applicant respectfully requests that the obviousness rejection of claims 48, 52, 55, 59, and 62 be withdrawn and that the claims be allowed.

### CONCLUSION

In view of the amendments and remarks set forth herein, Applicant respectfully submits that all pending claims are in condition for allowance and requests that a Notice of Allowance be issued. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is requested to telephone the undersigned at 512-338-9100.

#### CERTIFICATE OF TRANSMISSION

I hereby certify that on December 15, 2008 this correspondence is being transmitted via the U.S. Patent & Trademark Office's electronic filing system.

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Respectfully submitted,

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